

REMARKS

In the Final Office Action¹, the Examiner rejected claims 33-47, 49-63, 65-79, and 81-94 under 35 U.S.C. § 103(a) as being unpatentable over *Kara*, U.S. Patent No. 6,233,568 in view of *Manduley et al.*, U.S. Patent No. 5,324,893 ("*Manduley*"); and also rejected claims 33-47, 49-63, 65-79, and 81-94 under 35 U.S.C. § 103(a) as being unpatentable over *Ramsden et al.*, U.S. Patent No. 6,105,014 ("*Ramsden*") in view of *Manduley*.

By this Amendment, Applicants amend claims 33, 49, 65, 74, 81, and cancel claims 43, 44, 59, 60, 75, 76, 90, and 91 without prejudice or disclaimer. Claims 1-42, 45-58, 61-74, 77-89, and 92-96 are currently pending in this application, of which claims 33-42, 45-47, 49-58, 61-63, 65-74, 77-79, 81-94 are currently under Examination.

III. Rejection of Claims 33-47, 49-53, 65-79, and 81-94 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejection of claims 1, 3, 5, 7, 9, 11, 13, 15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Kara* in view of *Manduley*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]jections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P.

§ 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "The

¹ The Final Office Action contains a number of statements and declarations reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement, declaration, or characterization in the Final Office Action.

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established because the Final Office Action has neither properly determined the scope and content of the prior art nor the differences. Accordingly, no reason has been clearly articulated as to why the prior art would render the claimed invention obvious to one of ordinary skill in the art.

Claim 33 recites a method for receiving payment for postage, including, **"transmitting a postage payment adjustment amount** to the customer account based on a comparison between the first and second postage values, wherein transmitting the postage payment adjustment amount further comprises: **requesting additional payment when the second postage value is greater** than the first postage value, and **generating a credit when the second postage value is less** than the first postage

value.” The combination of *Kara* and *Manduley* does not teach, suggest, or make obvious at least these elements as recited in amended claim 33.

The Final Office Action acknowledges “*Kara* does not specifically teach . . . transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values.” Final Office Action, p. 3. Thus, it is undisputed *Kara* fails to disclose or suggest at least these elements of claim 33. In order to cure the deficiencies of *Kara*, the Final Office Action relies upon *Manduley*. *Id.* The Final Office Action is incorrect.

Manduley fails to cure these deficiencies of *Kara*. *Manduley* teaches verification of the required postage is present on a piece of mail. *Manduley*, col. 2, lines 13-15. The Final Office Action alleges *Manduley* teaches “transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values.” Final Office Action, p. 3. However, the Final Office Action is incorrect.

Manduley discloses:

In the alternative, particularly where the mailpieces have **no printed evidence of postage to compare**, at the NO branch of block 190, the postage due for the mailpiece is added to a running total, block 210, and the routine loops back to repeat the checking of the next mailpiece. When the last mailpiece is checked, decision block 220, the **postage due** for the entire mailing is **computed based on the verified sample and printed out along with the allowed margin for error**, block 230. This total can be compared with the manifested value of the mailing and additional postage **can be levied in the event the discrepancy exceeds some specified value.**

Manduley, col. 6, lines 23-34. *Manduley* teaches a method of using approximation to calculate possible underpayments of metered mail in batch mail processing. *Manduley* teaches keeping an account for underpayments in batch mail. There is no teaching or suggestion in *Manduley* of "transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values," as recited in claim 33.

Further, the Final Office Action fails to address how the prior art meets all of the elements of amended claim 33. Amended claim 33 includes elements previously included in now cancelled claims 43 and 44. The Final Office Action does explain how *Kara* or *Manduley* teach, suggest, or make obvious these elements, stating, "see reasoning applied to independent claim." Final Office Action, p. 5. Therefore the Final Office Action is incomplete as it fails to demonstrate how the prior art teaches, suggests, or renders obvious each and every claim element.

The Final Office Action correctly admits *Kara* does not teach or suggest transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values." Final Office Action, p. 3. Therefore, it is also undisputed that *Kara* fails to disclose or suggest transmitting the postage payment adjustment amount further comprises: requesting additional payment when the second postage value is greater than the first postage value, and generating a credit when the second postage value is less than the first postage value," as recited in amended claim 33. *Manduley* also fails to cure these deficiencies in *Kara*. *Manduley* discloses that a running total of estimated postage due is calculated for a customer. *Manduley*, col. 6, lines 23-37. In *Manduley*, a calculation of postage due from a

customer is determined over an entire mailing. *Id.* *Manduley* only levies postage due if the postage due exceeds a certain value. *Id.* There is no teaching or suggestion in *Manduley* of “transmitting . . . payment adjustment . . . comprises generating a credit,” as recited in amended claim 33. Thus, *Manduley* does not remedy the deficiencies of *Kara*, and the combination of *Manduley* and *Kara* does not teach, suggest, or make obvious “**transmitting a postage payment adjustment amount** to the customer account based on a comparison between the first and second postage values, wherein transmitting the postage payment adjustment amount further comprises: **requesting additional payment when the second postage value is greater** than the first postage value, and **generating a credit** when the **second postage value is less** than the first postage value,” as recited in amended claim 33.

In view of the mischaracterizations of the references discussed above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 33. Thus, the Office Action has failed to clearly articulate a reason why claim 33 would have been obvious to one of ordinary skill in the art in view of the prior art.

Independent claims 49, 65, and 81, while of different scope from claim 33, and each other, recite elements similar to those of claim 33 and are thus also allowable over *Kara* and *Manduley* for reasons similar to those discussed above for claim 33. Claims 34-42, 45-47, 50-58, 61-63, 66-74, 77-79, 82-94 are dependent at least due to their dependence upon the independent claims. Accordingly, a prima facie case of obviousness has not been established with respect to claims 33-42, 45-47, 49-58, 61-63, 65-74, 77-79, 81-94 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Claims 43, 44, 59, 60, 75, 76, 90, and 91 are cancelled rendering the rejection of these claims moot.

IV. Rejection of Claims 33-47, 49-53, 65-79, and 81-94 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejection of claims 1, 3, 5, 7, 9, 11, 13, 15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Ramsden* in view of *Manduley*. A *prima facie* case of obviousness has not been established.

Claim 33 recites a method for receiving payment for postage, including, **"transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values, wherein transmitting the postage payment adjustment amount further comprises: requesting additional payment when the second postage value is greater than the first postage value, and generating a credit when the second postage value is less than the first postage value."** The combination of *Ramsden* and *Manduley* does not teach, suggest, or make obvious at least these elements as recited in amended claim 33.

The Final Office Action acknowledges "Ramsden does not specifically teach: transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values." Final Office Action, p. 6. Thus, it is undisputed *Ramsden* fails to disclose or suggest at least these elements of claim 33. In order to cure the deficiencies of *Ramsden*, the Final Office Action relies upon *Manduley*. *Id.* The Final Office Action is incorrect.

As discussed above, *Manduley* fails to cure these deficiencies of *Ramsden*. *Manduley* teaches verification of the required postage is present on a piece of mail.

Manduley, col. 2, lines 13-15. The Final Office Action alleges *Manduley* teaches "transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values." Final Office Action, p. 6. However, the Final Office Action is incorrect.

Manduley discloses:

In the alternative, particularly where the mailpieces have no **printed evidence of postage to compare**, at the NO branch of block 190, the postage due for the mailpiece is added to a running total, block 210, and the routine loops back to repeat the checking of the next mailpiece. When the last mailpiece is checked, decision block 220, the **postage due** for the entire mailing is **computed based on the verified sample and printed out along with the allowed margin for error**, block 230. This total can be compared with the manifested value of the mailing and additional postage **can be levied in the event the discrepancy exceeds some specified value**.

Manduley, col. 6, lines 23-34. *Manduley* teaches a method of using approximation to calculate possible underpayments of metered mail in batch mail processing. *Manduley* only teaches keeping a running total to account for underpayments in batch mail, and, therefore, there is no teaching or suggestion in *Manduley* of "transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values."

Further, the Final Office Action fails to address how the prior art meets all of the elements of amended claim 33. Amended claim 33 includes elements previously included in now cancelled claims 43 and 44. The Final Office Action does not explain how *Kara* or *Manduley* teach, suggest, or make obvious these elements, stating, "see reasoning applied to independent claim." Final Office Action, p. 8. Therefore the Final

Office Action is incomplete as it fails to demonstrate how the prior art teaches or suggests each and every claim element.

The Final Office Action correctly admits *Ramsden* does not teach or suggest "transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values." Final Office Action, p. 6. Therefore, it is also undisputed that *Ramsden* fails to disclose or suggest transmitting the postage payment adjustment amount further comprises: requesting additional payment when the second postage value is greater than the first postage value, and generating a credit when the second postage value is less than the first postage value," as recited in amended claim 33. *Manduley* also fails to cure these deficiencies in *Ramsden*. *Manduley* discloses that a running total of estimated postage due is calculated for a customer. *Manduley*, col. 6, lines 23-37. In *Manduley*, a calculation of postage due from a customer is determined over an entire mailing. *Id.* *Manduley* only levies postage due if the postage due exceeds a certain value. *Id.* There is no teaching or suggestion in *Manduley* of "transmitting . . . payment adjustment . . . comprises generating a credit," as recited in amended claim 33. Thus, *Manduley* does not remedy the deficiencies of *Ramsden*, and the combination of *Manduley* and *Ramsden* does not teach, suggest, or make obvious **"transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values, wherein transmitting the postage payment adjustment amount further comprises: requesting additional payment when the second postage value is greater than the first postage value, and generating a credit when the second postage value is less than the first postage value,"** as recited in amended claim 33.

In view of the mischaracterizations of the references discussed above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 33. Thus, the Office Action has failed to clearly articulate a reason why claim 33 would have been obvious to one of ordinary skill in the art in view of the prior art.

Independent claims 49, 65, and 81, while of different scope from claim 33, and each other, recite elements similar to those of claim 33 and are thus also allowable over *Ramsden* and *Kara* for reasons similar to those discussed above for claim 33. Claims 34-42, 45-47, 50-58, 61-63, 66-74, 77-79, 82-94 are dependent at least due to their dependence upon the independent claims. Accordingly, a prima facie case of obviousness has not been established with respect to claims 33-42, 45-47, 49-58, 61-63, 65-74, 77-79, 81-94 and the rejection under 35 U.S.C. § 103(a) must be withdrawn. Claims 43, 44, 59, 60, 75, 76, 90, and 91 are cancelled rendering the rejection of these claims moot.

CONCLUSION

In view of the foregoing, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 24, 2009

By: /Erin M. File/
Erin M. File
Reg. No. 61,332